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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHELEHEDA, JAMES R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/508,869	Applicant(s) STAHL ET AL.	
	Examiner JAMES SHELEHEDA	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 12/03/08, with respect to the rejection(s) of claim(s) 1-17 under Ludtke and Osakabe have been fully considered and are persuasive.

Therefore, the rejection has been withdrawn in view of applicant's amendments.

However, upon further consideration, a new ground(s) of rejection is made in view of 7,068,920.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3, 7-8 and 12-17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5 and 7 of U.S. Patent No. 7,068,920.

Claim 1 discloses a peripheral consumer electronic device (corresponding to lines 1-4 of patented claim 1) comprising:

(a) means for communicating with a display device interconnected by a digital bus (corresponding to lines 1-11 of patented claim 1);

(b) means for providing digital video content (corresponding to lines 5-11 of patented claim 1);

(c) means for generating, in said peripheral consumer electronic device, digital OSD video data representative of an on-screen display menu associated with said peripheral consumer electronic device (corresponding to lines 14-20 of patented claim 1); and

(d) means for transferring said digital video content and said digital OSD video data as separate data via said digital bus to said display device, wherein at said display device said digital video content passes through a first signal path which decodes said digital video content to generate decoded digital video content and all menu data representative of menu content associated with said peripheral consumer electronic device including said digital OSD video data passes through a second signal path which does not decode said menu data or convert said menu data to a different format, and wherein outputs of said first and second signal paths are combined so that said on-screen display menu represented by said

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digital OSD video data is overlaid onto said decoded digital video content (corresponding to lines 12-22 of patented claim 1).

Claim 2 corresponds to patented claim 1, lines 12-20.

Claim 3 corresponds to patented claim 2.

Claim 7 discloses a method for controlling a peripheral consumer electronic device interconnected via an IEEE 1394 serial bus to a display device (corresponding to lines 1-3 of patented claim 5) comprising the steps of:

(a) transferring, to said display device, digital video content from said peripheral consumer electronic device utilizing an isochronous transfer mechanism of said serial bus (corresponding to lines 7-11 of patented claim 5);

(b) generating, in said peripheral consumer electronic device, digital video data representative of an on-screen display menu associated with said peripheral consumer electronic device (corresponding to lines 12-15 of patented claim 5); and

(c) transferring said digital video data via said serial bus to said display device utilizing an asynchronous transfer mechanism of said serial bus (corresponding to lines 6-18 of patented claim 5), wherein at said display device said digital video content passes through a first signal path which decodes said digital video content to generate decoded digital video content and all menu data representative of menu content associated with said peripheral consumer electronic device including said digital video data passes through a second signal path which does not decode said menu data or

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convert said menu data to a different format, and wherein outputs of said first and second signal paths are combined so that said on-screen display menu represented by said digital video data is overlaid onto said decoded digital video content (corresponding to lines 12-18 of patented claim 5).

Claim 8 corresponds to patented claim 6.

Claim 12 discloses a display device (corresponding to line 1 of patented claim 3), comprising:

(a) means for receiving, from a peripheral device, digital video content and for decoding said digital video content in a first signal path to generate decoded digital video content (corresponding to lines 2-10 of patented claim 3);

(b) means for receiving, from said peripheral device, digital video data representative of an on-screen display menu associated with said peripheral device, said digital video data and said digital video content being received as separate data via a digital bus, wherein all menu data representative of menu content associated with said peripheral device including said digital video data passes through a second signal path which does not decode said menu data .or convert said menu data to a different format (corresponding to lines 11-16 of patented claim 3) and

(c) means for combining outputs of said first and second signal paths by overlaying said digital video data onto said decoded digital video content and displaying

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said digital video data overlaid upon said decoded digital video content (corresponding to lines 17-20 of patented claim 3).

Claim 13 corresponds to patented claim 5.

Claim 14 corresponds to patented claim 1.

Claim 15 corresponds to patented claim 7.

Claim 16 corresponds to patented claim 7.

Claim 17 corresponds to patented claim 7.

4. Claims 4-6 and 9-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 7 of U.S. Patent No. 7,068,920 in view of Ludtke.

Claims 4 and 9 correspond to patented claim 1 except for the limitation of mapping the connectivity of each device on said serial bus.

In an analogous art, Ludtke' 069 discloses a system for connecting a peripheral consumer electronic device with a display through a digital bus (IEEE-1394; Col. 5, lines 35-60) which includes a mapping means for identifying the connectivity of the peripheral consumer electronic device with other devices on the digital bus (Fig. 5, Col. 8, lines 65- Col. 9, lines 35) for the typical benefit of enabling the system to coordinate a plurality of separate interconnected devices.

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify patented claim 1 to include mapping the connectivity

of each device on said serial bus, as taught by Ludtke, for the typical benefit of enabling the system to coordinate a plurality of separate interconnected devices.

Claim 10 corresponds to patented claim 2.

Claim 11 corresponds to patented claim 7.

As to claim 5, Ludtke further discloses means for receiving characteristic information of each device connected on said digital bus (Col. 9, lines 14-36).

Claim 6 corresponds to patented claim 1, lines 5-11.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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6. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____.
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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/
Examiner, Art Unit 2424

JS